UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,650	12/03/2001	Shell S. Simpson	10008254-1	7559

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EXAMINER
DIVINE, LUCAS

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/998,650	SIMPSON ET AL.
	Examiner	Art Unit	
	Lucas Divine	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 November 2005</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>8-14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>8-14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Claims 8 – 14 are pending.

Response to Arguments

2.   Applicant's arguments filed 11/28/05 have been fully considered but they are not

persuasive.

        With respect to applicant remarks on page 6 that Webb and Teng do not teach key

features of claim 8.

        In reply, Webb teaches that the program is provided to the host, and gives examples of

how it can be provided (col. 6 lines 56-67, as cited in initial rejection).   Webb also teaches that

this program code provides for all of the items listed in claim 8 (i.e. use a ..., automatically

display..., in response..., see rejection below). Thus, all Webb does not teach is that the

program code can be provided by a server in the system (although Webb also teaches the system

has standard file and print servers in the network in col. 2).   So all Webb is missing is, in a

printing system, providing code from a server to the client that allows the client see information

on the printer and control the printer. Teng teaches this in the Internet printing system, providing

html code data to the host for performing printer operations and seeing information on a printer.

Thus, Teng teaches that a server, in a printing system, can provide the program information for

the host in the system of Webb. Further, Examiner submits that file/print servers (such as the

ones in Webb) were known in the art to provide program files (such as print drivers and all sorts

of programs) in a networking system.   Also noted are that the server of claim 8 just receives a

request from a client and provides program code, which Teng teaches.

With respect to applicant remarks on page 7 that the references do not teach or suggest a

printer that includes an embedded server that serves a program that enables a client to use the

same printer to print a document.

In reply, in the system of Webb (Fig. 1) and Teng (Fig. 2) they're examples include

systems with only one printer. Therefore, if the printer includes a server (as is taught in

Yoshida), the only printer in the system would provide the program data in the combination, and

therefore 'the same printer' limitation is met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 8 and 10 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Webb et al. (US 5727135) in view of Teng et al. (US 6327045).

Regarding claims 8 and 14, Webb teaches **a server** (col. 2 the paragraph of lines 10-16,

wherein servers can be part of the LAN 21 of Fig. 1 as connected to the client and printer

through the LAN), the host **comprising:**

(b) a program of computer readable instructions to the client (col. 6 lines 56-67, wherein program for completion the below functions is transmitted to the computer, which can be loaded onto the machine in various forms, one example being by a floppy disk), **the program for enabling the client to:**

i) use a specific printer (16, Fig. 1) **to print a document, the printer having a user input key** (40a-d, 45, 46, Fig. 1)**; and**

ii) automatically display (Fig. 1, 35') **an image of the key** (40a-d', 45', 46', Fig. 1) **while the printer is printing the document** (the status and control of the print job imply controlling the print job while it is being processed; **and**

iii) in response to receiving a user selection of the key image while the printer is printing the document, cause the printer to perform a particular function (col. 3 lines 55-67, col. 10 lines 60-67, Fig. 4, 200, col. 4 lines 5-9).

Webb clearly suggests using print and file servers for routing print jobs and providing files in the background of the invention. Web also teaches the system is implemented on a network through a LAN. Webb teaches that the program is provided to the host, and gives examples of how it can be provided (col. 6 lines 56-67, as cited in initial rejection). Thus, all Webb does not teach is that the program code can be provided by a server in the system (although Webb also teaches the system has standard file and print servers in the network in col. 2). So all Webb is missing is, in a printing system, providing code from a server to the client that allows the client see information on the printer and control the printer.

Teng teaches this in the Internet printing system, providing html code data to the host for performing printer operations and seeing information on a printer, i.e. printer administration as

done in Webb. Teng teaches that a server, in a printing system, can provide the program

information for the host (wherein the Figs. 8 – 10 show the html program code provided from the

server to the client that allows the user to control and view information of the printing apparatus,

see associated cols and lines of the figures). Teng teaches a client, server, printer system (Fig. 2)

including receiving requests from the user and sending html to the user (Fig. 7) to control

printing operations (Figs. 8 – 14).

It would have been obvious to one of ordinary skill in the art that the LAN/Server

printing system of Webb could have been implemented in an Internet printing system such as

that of Teng and thus the program code could have been provided by the server to the user in

Webb as taught in Teng. The motivations for doing so would have been to use all of the

beneficial features of the Internet in the printing system and to provide for the user to even be

more remote from the printer (for example, not in the LOCAL area network). Also, instead of

having to update a program by taking a 3.5 inch floppy disk to each individual computer in order

to download new printer programs (col. 6 line 62 as one example of a way of providing the

program), the server can just updated it when the user accesses it for printing.

Regarding claim 10, which depends from claim 8, Webb teaches that one of the functions

that the panels perform is a **cancel** function in col. 2 line 59, as well as the stop function in Table

I (col. 10) appears to perform the canceling function. Also, Teng shows canceling in Fig. 8.

Regarding claim 11, which depends from claim 8, Webb teaches in col. 10 line 41 that

one of the many options that can be controlled and selected locally and remotely is paper size –

'**media having a particular dimension**'. Teng shows it in Fig. 9.

Regarding claim 12, which depends from claim 8, Webb teaches that the two displays are

virtually the same to the walk up user and the remote user (col. 3 lines 55 – col. 4 line 25, col. 7

lines 1-15)

Regarding claim 13, which depends from claim 8, Webb teaches **the client is a personal**

computer (computer 11, Fig. 1) **connected to the server over a network** (Fig. 1, network 21).

4.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webb and Teng as

applied to claim 8 above, and further in view of Yoshida et al. (US 6130757).

Regarding claim 9, which depends from claim 8, while Teng teaches Web server (Fig. 2)

for interacting with a client in a printing system, the combination does not specifically that the

Web server is an embedded server in the printer.

However, it is known in the art, and Yoshida teaches, a printer that can act as a printer

server or a printer client for controlling other network image forming devices, thus including

image forming and print server related functions (multi-function device 1 as shown in Fig. 1; col.

4 lines 30-31, col. 9 lines 15-16, col. 9 line 1).

It would be obvious to one of ordinary skill in the art that the functionality of the server

in the combination of Webb and Teng could have been implemented in a sophisticated printer

such as that of Yoshida. The motivations for doing so would have been to reduce complexity by

having all functionality needed at one device instead of two and it would allow image forming

apparatuses to directly connect to the clients instead of having delays in transmission because of

the data having to go through separate information processing apparatuses. Thus, the system is

simplified by having less network and computing complexity and the system is faster by having

the data on the network only transferred once and having internal (fast buses) connections

between server and printing units instead of external (slower network transmission).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

Image: A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The

examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2625

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